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1626  
#10  
8/16/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Michael Konkel et al.

Serial No.: 09/764,710

Examiner: A.D. Small

Filed: January 17, 2001

Group Art Unit: 1626

For: COMPOUNDS SPECIFIC FOR THE  $\alpha_{1d}$  HUMAN ADRENERGIC  
RECEPTOR AND USES THEREOF

1185 Avenue of the Americas  
New York, New York 10036  
August 1, 2002

Assistant Commissioner of Patents  
Washington, D.C. 20231

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Sir:

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COMMUNICATION IN RESPONSE TO JULY 3, 2002 OFFICE ACTION

This Communication is submitted in response to the Office Action issued July 3, 2002 in connection with the above-identified application. A response to the July 3, 2002 Office Action is due August 3, 2002. Accordingly, this Communication is being timely filed.

REMARKS

Restriction Requirement Under 35 U.S.C. §121

In the July 3, 2002 Office Action, the Examiner to whom the subject application is assigned stated that restriction to one of the following inventions is required under 35 U.S.C. §121:

- I. Claims 1-42, drawn to methods of inhibiting activation of a human  $\alpha_{1d}$  adrenergic receptor which comprises contacting the receptor with a compound according to claim 5 wherein X is N; and

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II. Claims 1-10, 13-19, 22-30 and 32-42, drawn to methods of inhibiting activation of a human  $\alpha_{1d}$  adrenergic receptor which comprises contacting the receptor with a compound according to claim 5 wherein X is C.

The Examiner alleged that the inventions are distinct, each from the other because of the following reasons: the inventions of Groups I and II are independent and distinct because there is no patentable co-action between the groups and a reference anticipating one member will not render another obvious. The Examiner alleged that each group is directed to art recognized divergent subject matter, which requires different searching strategies for each group. The Examiner asserted that a commercial database search must be performed on the subject matter of each group in addition to a paper search, which the Examiner stated is quite burdensome to the Examiner.

The Examiner stated that because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

The Examiner advised applicants that a reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. §1.143).

In response to this restriction requirement, applicants hereby elect, with traverse, to prosecute the invention identified by the Examiner as Group I, i.e. claims 1-42, drawn to methods of inhibiting activation of a human  $\alpha_{1d}$  adrenergic receptor which comprises contacting the receptor with a compound according to claim 5 wherein X is N.

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Applicants note that 35 U.S.C. §121 states, in part, that "[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." [Emphasis added]. Applicants request that the restriction requirement be withdrawn in view of the fact that the claims of the Groups I and II are not independent.

Under M.P.E.P. §802.01, "independent" means "there is no disclosed relationship between the ... subjects disclosed, that is, they are unconnected in design, operation, or effect... ." The claims of Groups I and II are related in that they are drawn to methods of inhibiting activation of a human  $\alpha_{1d}$  adrenergic receptor which comprises contacting the receptor with compounds which differ between the two groups only in regard to whether one atom is C or N.

Applicants therefore respectfully assert that two independent and distinct inventions have not been claimed in the subject application because the groups are not independent under M.P.E.P. §802.01.

Additionally, applicants point out that under M.P.E.P. §803, the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination of an application can be made without serious burden. There are two criteria for a proper requirement for restriction, namely (1) the inventions must be independent and distinct; AND (2) there must be a serious burden on the Examiner if restriction is not required.

Applicants maintain that there would not be a serious burden on

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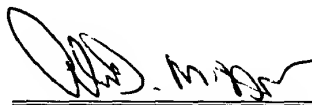
the Examiner if restriction were not required. A search of prior art with regard to either of Groups I or II would necessarily identify art for the other Group. Since there is no serious burden on the Examiner to examine Groups I-II in the subject application, the Examiner must examine the entire application on the merits.

Accordingly, in view of the preceding remarks, applicants respectfully request that the Examiner reconsider and withdraw the requirement for restriction.

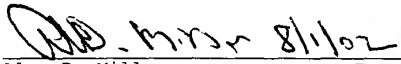
If a telephone conference would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone the number provided below.

No fee is deemed necessary in connection with the filing of this Communication. However, if a fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



John P. White  
Registration No. 28,678  
Alan D. Miller  
Registration No. 42,889  
Attorney for Applicants  
Cooper & Dunham LLP  
1185 Avenue of the Americas  
New York, New York 10036  
(212) 278-0400

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| I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231. |        |
|   | 8/1/02 |
| Alan D. Miller<br>Reg. No. 42,889  | Date   |